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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/885,213

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Stephan Kleier

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06/18/2004

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EXAMINER

ELAHEE, MD S

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 06/18/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/885,213

Applicant(s)

KLEIER ET AL.

Examiner

Md S Elahee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-21 and 23-27 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-21 and 23-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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DETAILED ACTION

Response to Amendment

1. This action is responsive to an amendment filed on 03/24/04. Claims 1-6, 8-21 and 23-27 are pending. Claims 7 and 22 have been cancelled.

Response to Arguments

2. Applicant's arguments have been fully considered but are moot in view of the new ground(s) of rejection which is deemed appropriate to address all of the added limitations at this time.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 10, 11, 13, 17-21 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (U.S. Patent No. 6,505,040) and in view of Lowery et al. (U.S. Patent No. 6,148,068).

Regarding claim 1, Kim teaches storing a list of multiple parties (i.e., a predetermined group of subscribers) (col.1, lines 66, 67, col.2, lines 1-10, 47-51).

Kim further teaches contacting, when a telephone conference is requested for the multiple parties (i.e., predetermined group of subscribers) stored in the list, the parties taken from the stored list of parties for preparing for setting-up a telephone conference between the parties by sending an invitation to the remote multiparty conference (i.e.,

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telephone conference) to parties (i.e., subscribers) who are stored in the list (col.2, lines 1-22, 47-51).

Kim further teaches setting up a telephone conference by connecting those multiple parties that has connection confirmation (col.2, lines 3-22). (Note: it is inherent that since the remote party answers the call, the network detects the connection establishment with the party, therefore, the inviter receives the connection confirmation)

However, it is not clear whether Kim teaches connecting only those subscribers that input an acceptance of the invitation. Lowery teaches connecting only those subscribers that input an acceptance of the invitation (abstract; fig.2; col.1, lines 46-53, col.2, line 62-col.3, line 5). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kim to connect only those subscribers that input an acceptance of the invitation as taught by Lowery. The motivation for the modification is to have doing so in order to provide an indication of whether the subscribers desire to be conference participants.

Regarding claims 2 and 17, Kim teaches the telephone conference is a mobile radio telephone conference in which the least one subscriber participates via a mobile radio network (abstract; col.2, lines 1-22, 47-56).

Regarding claims 3 and 18, Kim teaches requesting the telephone conference via a mobile radio telephone network (abstract; col.2, lines 1-22, 47-56).

Regarding claim 4, Kim teaches the steps of contacting and setting up are initiated by calling a telephone number not associated with any other subscriber, whereupon, when the number is called, the telecommunication network connects subscribers on the list to

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the telephone conference in accordance with the steps of contacting and setting up (col.2, lines 1-22, 47-56, col.3, lines 52-62).

Regarding claims 5 and 20, Kim teaches providing a limited number of mobile radio telephone numbers (IMSI) in at least one mobile radio telecommunication network, whereupon when the numbers are called by any mobile radio subscriber, a telephone conference is set up to this mobile radio subscriber (col.2, lines 1-22, 47-56, col.3, lines 52-62).

Regarding claims 6 and 21, Kim teaches after a telephone conference has been requested by a subscriber, sending a message via a device at the mobile radio network end to the subscribers who are contained in the list for which list a telephone conference has been requested, and taking one of telephone numbers and other telecommunication identities of the subscribers from a list stored in one of the mobile radio network and by the subscriber requesting the telephone conference (col.2, lines 1-22, 47-56, col.3, lines 52-62).

Regarding claim 10, Kim teaches that the storing step includes storing, for the group, in each case a list of at least one of names, telephone numbers and other telecommunication addresses of only each subscriber in the group but no other subscriber in at least one of the mobile terminal, a mobile radio subscriber identification card and the telecommunication network (abstract; col.2, lines 1-22, 47-56).

Regarding claims 11 and 26, Kim teaches admitting only subscribers who are stored in a list for a group to a telephone conference for this group (abstract; col.2, lines 1-22, 47-56).

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Regarding claim 13 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Kim teaches a mobile phone to conference mode (i.e., control device) operative so that, when a telephone conference is requested for a multiple parties (i.e., a predetermined group of subscribers) by a party of a telecommunication network, the control device contacts parties of the predetermined group of parties, which parties are stored in a list for this group, for preparing the setting-up of a telephone conference between the parties (col.1, lines 66, 67, col.2, lines 1-10, 47-51).

Regarding claim 19, Kim teaches that the control device is operative for sending an invitation to the telephone conference to subscribers who are stored in the list when a telephone number which is associated with no other subscriber is called (abstract; col.2, lines 1-22, 47-56, col.3, lines 52-62).

5. Claims 8, 12, 14-16, 23 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (U.S. Patent No. 6,505,040) and in view of Lowery et al. (U.S. Patent No. 6,148,068) and further in view of Wu (U.S. Patent No. 6,275,575).

Regarding claims 8 and 23, Kim in view of Lowery fails to teach “transmitting the invitation as one of a short message service (SMS) message and WML content to the terminal”. Wu teaches transmitting the request (i.e., invitation) as one of a short message service (SMS) message and WML content to the terminal (col.6, lines 10-16, col.7, lines 13-25). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kim in view of Lowery to transmit the invitation as one of a short message service (SMS) message and WML content to the terminal as taught by

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Wu. The motivation for the modification is to have doing so in order to provide a conventional means to deliver conference related text.

Regarding claims 12 and 27, Kim in view of Lowery fails to teach “defining a list with regard to subscribers contained therein by at least one of mobile radio Internet (WAP) and landline network Internet”. Wu teaches defining a list with regard to subscribers contained therein by at least one of mobile radio Internet (WAP) and landline network Internet (col.6, lines 66, 67, col.7, lines 1-12). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kim in view of Lowery to define a list with regard to subscribers contained therein by at least one of mobile radio Internet (WAP) and landline network Internet as taught by Wu. The motivation for the modification is to have doing so in order to facilitate intra-network communications.

Regarding claim 14, Kim in view of Lowery fails to teach “the device is a server one of in a telecommunication network and having access to a telecommunications network”. Wu teaches that the device is a server one of in a telecommunication network and having access to a telecommunications network (abstract; col.6, lines 66, 67, col.7, lines 1-12). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kim in view of Lowery to the device as a server one of in a telecommunication network and having access to a telecommunications network as taught by Wu. The motivation for the modification is to have doing so in order to initiate a multiparty telephone conference.

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Regarding claim 15, Kim in view of Lowery fails to teach “the control device includes an interface for receiving a request of a subscriber for setting up a telephone conference, and an interface for connecting subscribers to one another as a telephone conference”. Wu teaches that the control device includes an interface for receiving a request of a subscriber for setting up a telephone conference, and an interface for connecting subscribers to one another as a telephone conference (col.6, lines 10-16, col.7, lines 13-25). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kim in view of Lowery to have the control device including an interface for receiving a request of a subscriber for setting up a telephone conference, and an interface for connecting subscribers to one another as a telephone conference as taught by Wu. The motivation for the modification is to have doing so in order to provide a conventional means to deliver conference related text.

Regarding claim 16, Kim teaches after the setting-up of the telephone conference has been prepared, a voice telephone conference is inherently established (col.1, lines 66, 67, col.2, lines 1-10, 47-51).

6. Claims 9, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (U.S. Patent No. 6,505,040) and in view of Lowery et al. (U.S. Patent No. 6,148,068) and further in view of Bradshaw, Jr. (U.S. Patent No. 6,608,820).

Regarding claims 9 and 24, Kim in view of Lowery fails to teach “controlling a telephone conference with an element at the mobile radio network end during the telephone conference with regard to at least one of termination of the conference, exclusion of a subscriber from the conference and addition of a further subscriber, not

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contained in the list, to the conference". Wu teaches controlling a telephone conference with an element at the mobile radio network end during the telephone conference with regard to at least one of termination of the conference, exclusion of a subscriber from the conference and addition of a further subscriber, not contained in the list, to the conference (abstract; col.4, lines 17-36). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kim in view of Lowery to control a telephone conference with an element at the mobile radio network end during the telephone conference with regard to at least one of termination of the conference, exclusion of a subscriber from the conference and addition of a further subscriber, not contained in the list, to the conference as taught by Wu. The motivation for the modification is to have doing so in order to make the required change to the number of participants in the conference.

Regarding claim 25, Kim teaches that for the group, in each case a list of at least one of names, telephone numbers and other telecommunication addresses of each subscriber of the group but no other subscribers is stored at least one of in the mobile terminal, in a mobile radio subscriber identification card and in a memory in the telecommunication network (abstract; col.2, lines 1-22, 47-56).

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Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Vainio et al. (U.S. Patent No. 6,577,721) teach Conference call and Sammon et al. (U.S. Patent No. 6,563,914) teach Personal web-based teleconferencing method and system.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S Elahee whose telephone number is (703)305-4822. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703)305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M.E.

MD SHAFIUL ALAM ELAHEE

June 14, 2004

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